REMARKS

In response to the Office Action dated September 13, 2000, claims 1 and 2 have been amended. Claims 1-17 remain in the case. Reexamination and reconsideration of the amended application are requested.

Double Patenting

Claims 1-8 and 11-16 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9, 11, 13-17 and 19 of co-pending U.S. application number 09/156,766.

The Applicants note that this is a provisional obviousness-type double patenting rejection and will answer when the above-mentioned co-pending application is patented.

Section 103(a) Rejections

The Office Action rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. (U.S. Patent No. 6,012,044). In particular, the Office Action contended that Maggioncalda et al. disclose each and every element of the Applicants' invention, except for transmitting rules of enforcement, preventing sub-item conflicts with the transmitted rules of enforcement and processing the rules of enforcement for sub-item combinations in the background. However, the Office Action maintained that it would have been obvious for these steps to be necessarily included in Maggioncalda et al. in order to allow the system of Maggioncalda et al. to process and display sub-items logically and properly.

The Applicants respectfully traverse this rejection based on the claim amendments and the arguments below. In particular, the Applicants maintain that Maggioncalda et al. do **not** disclose, suggest or provide any motivation for claimed features of the Applicants' claimed invention. Further, the cited reference completely **fails** to appreciate the advantages of these claimed features.

To make a prima facie showing of obviousness, all of the claimed features of an Applicant's invention must be considered, especially when they are missing from the

prior art. If a claimed feature is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie showing of obviousness has been made. The Federal Circuit Court has held that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Moreover, if the prior art reference does not disclose, suggest or provide any motivation for at least one claimed feature of an Applicant's invention then a prima facie case of obviousness cannot be established (MPEP § 2142).

In particular, amended claim 1 of the Applicants' invention includes a method for dynamically displaying data values including transmitting results, sub-items associated with the results, and rules of enforcement of sub-item combinations. These results, associated sub-items and rules of enforcement of sub-item combinations are transmitted from a server to a remote client in response to a request from the client to the server. Moreover, the transmitted rules of enforcement are used to prevent sub-item conflicts on the client.

In contrast, Maggioncalda et al. merely disclose a user interface for a financial advisory system that provides a user with interactive exploration of how changes in input values affect output values. The financial advisory system includes a number of different visual indications and a graphical input mechanism having a number of settings is used to receive a desired level of investment risk. Although a system of servers and a client do interact with and receive feedback from each other, there is **no** mention or disclosure of the Applicants' claimed transmitting rules of enforcement of sub-item combinations from a server to a client in response to a request from the client. Moreover, Maggioncalda et al. **fails** to disclose the Applicants' claimed preventing of sub-item conflicts using the transmitted rules of enforcement.

The Office Action, in fact, admits that Maggioncalda et al. does not disclose the Applicants' steps of transmitting of the rules of enforcement and preventing sub-item conflicts using these transmitted rules. However, the Office Action maintains that it would have been obvious for "these steps to be necessarily included in a method such as Maggioncalda et al. in order to allow the system to process and display sub-items in

combination logically and properly, especially when mutually exclusive of each other." The Applicants, however, respectfully disagree with this statement.

Specifically, the Applicants maintain that Maggioncalda et al. completely fail to provide any motivation, suggestion or desirability to modify their financial advisory system to include the Applicants' claimed step of transmitting the rules of enforcement from a server to a client in response to a request from the client. One reason for this is that Maggioncalda et al. merely present through a user interface on a client a constrained set of decisions that are always feasible (col. 8, lines 50-54). The user interacts with these decisions to create a result that includes a recommended set of financial products and their projected outcomes (col. 8, lines 66-67; col. 9, lines 1-2). The constrained set of decisions is already present on the client prior to any results being obtained. Thus, there is no need for the system of Maggioncalda et al. to transmit results, sub-items associated with those results and rules of enforcement in response to a request because by the time the results are obtained the constrained set of decisions are no longer needed.

On the other hand, the Applicants' invention permits a user to make a request, and then transmits results of that request, sub-items associated with the results and rules of enforcement. Moreover, the present invention permits the user to interact with the transmitted results on the client subject to the transmitted rules of enforcement. These transmitted rules of enforcement of sub-item combinations contain "all potential configurable conflicts between sub-items to thereby prevent the user from creating any sub-item conflicts during adjustment of the sub-items" (specification, page 20, lines 5-7). Thus, in the Applicants' invention transmitted rules of enforcement are used to prevent sub-item combination conflicts of the results on the client. Maggioncalda et al. simply does not have a need for these transmitted rules of enforcement because by the time the results are obtained a constrained set of decisions are no longer needed. Absent any type of motivation or suggestion, therefore, Maggioncalda et al. cannot render the Applicants' invention obvious (MPEP § 2143.01).

Maggioncalda et al. also **fail** to appreciate or even recognize the advantages of these claimed features of the Applicants' invention. Namely, the Applicants' step of transmitting the rules of enforcement from the server to the client along with the results enables a user to interact with the transmitted results on the client and to avoid sub-item conflicts during this interaction (specification, page 5, lines 8-10). Moreover, the transmitted rules of enforcement enable the user to quickly access and adjust information dynamically and in real time without server delays (specification, page 5, lines 15-16). Nowhere do Maggioncalda et al. discuss or appreciate these advantages of the Applicants' claimed steps of transmitting rules of enforcement and preventing sub-item conflicts with those transmitted rules.

Clearly, Maggioncalda et al. do not disclose, suggest or provide any motivation for the claimed features of the Applicants' invention. Further, Maggioncalda et al. completely **fail** to appreciate the advantages of these claimed features. Therefore, as set forth in *In re Fine* and MPEP § 2142, the cited reference does not render the Applicants' claimed invention obvious because the reference is missing at least one material feature of the Applicants' invention. Consequently, because a prima facie case of obviousness **cannot** be established due to the lack of "some teaching, suggestion, or incentive supporting the combination", the rejection must be withdrawn. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Claim 2 of the Applicants' invention includes a set of results, criteria associated with the set of results, and rules of enforcement that are transmitted from a server to a client in response to a request from the client. In addition, claim 2 includes at least one adjustable interface option that enables adjustment of the associated criteria within the confines of the transmitted rules of enforcement. The Applicants submit that claim 2 is non-obvious over Maggioncalda et al. based on the arguments above.

Claim 13 of the Applicants' invention includes transmitting pricing data, associated options and rules for selection from a server to a client and displaying the pricing data in response to user interaction with the transmitted rules for selection.

The Applicants submit that claim 13 is non-obvious over Maggioncalda et al. based on the arguments above.

Moreover, dependent claims 6-12 depend from independent claim 1, dependent claims 3-5 depend from independent claim 2, and dependent claims 14-17 depend from independent claim 13 and are therefore also nonobvious over the cited reference (MPEP § 2143.03). In view of the claim amendments and the arguments set forth above, the Applicants respectfully submit that the rejection of claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. has been overcome and that the pending claims in this application are in immediate condition for allowance. The Examiner, therefore, is respectfully requested to withdraw the outstanding rejections and pass this application to issue. Furthermore, in an effort to further and expedite the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicant's attorney at (805) 278-8855 or (805) 383-0017 if the Examiner has any questions or concerns.

Respectfully submitted,
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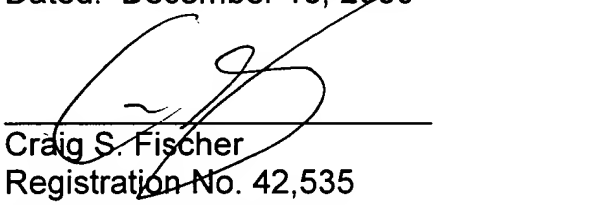

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